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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,966	02/10/2006	Arnold Keller	246472009300	5675
25227 7590 04/01/2009 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				
EXAMINER				
COMSTOCK, DAVID C				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/567,966

**Applicant(s)**

KELLER, ARNOLD

**Examiner**

DAVID COMSTOCK

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2008 and 09 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 July 2008 (as well as the supplemental amendment filed 09 September 2008) has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young (US Pat 7,011,658) in view of Nicosia et al. (US Pat 6,729,515)

Young teaches a device with two tubular pin holders (Figure 5 Elements A<sub>1</sub> and A<sub>2</sub>) connected to a parallel guide system (Figure 5 Element 30), and can have two pins (Figure 5, two threaded elements in direct contact with V<sub>1</sub> and V<sub>2</sub>). Young does not

teach a device where at least one pin holder has a locking device. Nicosia et al. discloses a latching assembly/locking device with at least one transverse groove (Figure 8, the area between Elements 105 and 50) and a hook portion/locking finger (Figure 11 Element 67) that is able to move from a locked position and a release position (Figure 14 and Figure 10, respectively). Young and Nicosia et al. are analogous art because they are concerned with a similar technical difficulty, namely a means of fastening, wherein the means is secure and easy to operate. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Nicosia et al. locking mechanism in the Young bone device. The motivation would have been to offer an equivalent and alternative means of securing the tubular pin in place--especially in order to have a means of fastening that is secure and easy to operate (see MPEP § 2144.06). Regarding claim 2, Young teaches a similarly claimed device as explained in Claim 1. Young does not teach a device in which the locking finger is designed like a hook that is mounted at the open end of a pin holder and is movable around an axis. Nicosia et al. discloses a latching assembly/locking device with a hook portion/locking finger (Figure 11 Element 67) mounted at the end of the threaded stud/pin holder (Figure 9 Element 89) that is movable about an axis. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Young's bone device with Nicosia et al.'s locking mechanism. The motivation would have been to offer an alternative means of fastening the pin in place that is both secure and easy to operate (see MPEP § 2144.06).

***Response to Arguments***

In response to Applicant's amendment and arguments, it is noted that the device of Young is a parallel guide system and comprises a guide bar. A locking finger is at least capable of engaging in a groove in a locking position. The tubular pin holders can be seen as being arranged in many planes passing through an axis of each of the holders, among which are planes that are perpendicular to the guide bar. The amended claim language "axially introduced into the pin holders" amounts to a product-by-process limitation. As such, in claims directed to the product, the process is not relevant to the final product unless Applicant can demonstrate with proper evidence that the process results in a distinct product as a result of the process. Absent such evidence, it appears that the device of the prior art satisfies the claimed invention in this regard. Finally, Examiner agrees with Applicant's statement in the remarks at page 3, lines 22-23: "The mere fact that Nicosia discloses a fastening mechanism does make Nicosia analogous art." While nobody is attempting to argue that Nicosia is in the same field of Applicant's endeavor, the second prong of the test for determining analogous art is satisfied. Specifically, the reference is reasonably pertinent to the particular problem with which the inventor was concerned, namely, with creating a latching mechanism that is both secure and easy to operate. The nexus between the two would arise quite naturally from a prior art search, including a keyword search--which certainly should be conducted as part of a complete search by or on behalf of a person of ordinary skill in the art. In determining whether art is analogous, the existence of ubiquitous, Internet-

based, text-searchable databases, to which a person of ordinary skill in the art can be presumed to have access to, cannot be disregarded.

In addition, Examiner's previous arguments are incorporated below inasmuch as they are still pertinent to the claimed invention.

In response to applicant's argument that Young et al. and Nicosia et al. are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the locking mechanism of Nicosia et al. relates to a similar technical difficulty.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). A locking mechanism designed for a motorcycle support will solve the same problem as a locking mechanism designed for a medical device, namely, provide a secure and easy fastening means.

In response to applicant's argument that Nicosia et al. does not disclose or suggest a locking device configured to restrict the movement of the pin along the pin axis by engaging a transverse groove on the pin or a tubular pin holder that restricts the lateral movement of the pin, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, Nicosia et al. disclose a locking device that is capable of restricting the movement of the pin.

In response to applicant's argument that there is no teaching of a pin having a transverse groove, Young discloses a pin with at least transverse groove (Figure 5, the threaded elements embedded in  $V_1$  and  $V_2$  have at least one transverse groove). The locking finger of Nicosia et al. is capable of engaging the groove of Young's pin.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733